

Attorney Docket No.: DEX-0142
Inventors: Macina et al.
Serial No.: 09/802,674
Filing Date: March 9, 2001
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REMARKS

Claim 1 is pending in the instant application. Claim 1 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication Number 2003/0109690. The Examiner suggests that this published patent application teaches sequence 4637, which is the same as Applicants' polypeptide sequence, SEQ ID NO:4. The Examiner has acknowledged that this published patent application does not teach the explicit use of this sequence which is 100% identical to Applicants SEQ ID NO:4. However, the Examiner suggests that it would have been prima facie obvious at the time of the claimed invention to implement the teachings of the patent in order to detect the presence of gastrointestinal cancer in a patient. The Examiner suggests that one of ordinary skill in the art would have been motivated by teachings of the patent application that performing the taught method with the 100% sequence identical polypeptide, sequence 4637 would yield a result indicative of the presence or absence of gastrointestinal cancer and arrive at a more definitive diagnosis in order to allow health professionals to employ preventative measured or aggressive treatment earlier thereby preventing the development of further progression of the cancer (paragraph bridging page 63-64).

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Applicants respectfully traverse this rejection.

At the outset, it is respectfully pointed out that the sequence reference of 4637 appears to be incorrect. Applicants believe that the proper sequence for comparison is 4627.

Further, paragraph 409 of U.S. Patent Application Publication Number 2003/0109690 teaches that "in general, colon or colon cancer antigen polypeptides should be present at a level that is at least three fold higher in disease tissue than in normal tissue. In contrast, in the present invention a decrease, and more specifically at least a 2-fold decrease was observed in gastrointestinal cancer tissue as compared to normal tissue. In an earnest effort to advance the prosecution of this case and in accordance with teachings at page 18, lines 28-34 and Table beginning at page 48 of the instant application, Applicants have amended claim 1 to state that at least at least a two-fold decrease in determined levels of SEQ ID NO:3 or a polynucleotide encoding a polypeptide comprising SEQ ID NO:4 in said patient versus normal human control is associated with the presence of gastrointestinal cancer.

U.S. Patent Application Publication Number 2003/0109690 clearly teaches away from the invention as now claimed and thus provides no reasonable expectation of success with respect to the

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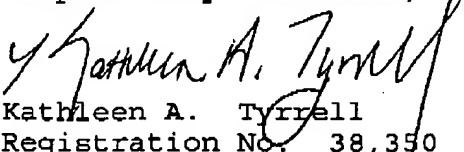
instant invention nor a teaching or suggestion of all claim limitations as required to render the instant invention prima facie obvious. See MPEP § 2143.

It is therefore respectfully requested that this rejection under 35 U.S.C. § 103(a) be withdrawn.

Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,


Kathleen A. Tyrrell
Registration No. 38,350

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Licata & Tyrrell P.C.
66 E. Main Street
Marlton, New Jersey 08053

(856) 810-1515